

REMARKS

The present application relates to hybrid maize plant and seed 38A24. Claims 1-42 are currently pending in the present application. Claims 9-11, 13-19, 22-24, 26-32, 34-40 have been canceled. Claims 43-54 have been added. Applicant respectfully requests consideration in view of the following remarks.

Detailed Action*A. Status of the Application:*

Applicant acknowledges the objection to the specification for the presence of a blank line on page 7 as withdrawn. Applicant also acknowledges the objection to claims 6, 12, 16, 25 and 29 as withdrawn. The rejection of claims 1-32 under 35 U.S.C. § 112, second paragraph, are acknowledged as withdrawn. Applicant further acknowledges the rejection of claims 1-32 under 35 U.S.C. § 112, first paragraph, requiring a deposit of the maize seed of the invention as withdrawn in light of the deposit and the deposit statement in the specification and the paper received November 13, 2002. Finally Applicant acknowledges the rejection of claims 1-32 under 35 U.S.C. § 102(e)/§103(a) as withdrawn.

*B. Specification*

Applicant submits the Deposit section has been amended in order to properly include both the hybrid maize plant 38A24 and the inbred parents GE533340 and GE501400 within the Deposit paragraph. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The specification has now been amended to correct these minor changes.

In addition, Applicant respectfully submits that at least 2,500 seeds of hybrid maize plant 38A24 and the inbred parents GE533340 and GE501400 have been made. The specification has now been amended to contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository. The claims have also been amended to recite the proper ATCC deposit number. Applicant further asserts that the deposits have been made without restriction.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 8, 11, 15, 19, 21, 24, 28, 32, 34 and 38-42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 8, 21 and 41 stand rejected for the recitation "genetic factor" as rendering the claims indefinite.

Applicant has now amended claims 8, 21, and 41 to include the recitation --transgene--, as suggested by the Examiner, thus alleviating this rejection. Applicant thanks the Examiner for the suggested language.

Claims 11, 15, 19, 24, 28 and 32 stand rejected as being indefinite for the recitation "significantly different" as the metes and bounds of the claims are not clear.

Applicant has canceled claims 11, 15, 19, 24, 28 and 32, thereby alleviating this rejection.

The Examiner rejects claims 11, 15, 19, 24, 28, 32, 38 and 39 for the recitations "has derived at least 50% of its alleles" in claims 11, 15, 19, 24, 28, and 32, and "deriving at least 50% of its alleles" in claims 38 and 39 rendering the claims indefinite. The Examiner states it is not clear what is meant by "derived" and "deriving".

Applicant has canceled claims 11, 15, 19, 24, 28, 32, 38 and 39, alleviating this rejection.

The Examiner rejects claim 34 for the recitation "essentially" in line 3 which renders the claim indefinite. The Examiner states the recitation makes the metes and bounds of the claim unclear.

Applicant has canceled claim 34, thus alleviating this rejection.

Claim 38 stands rejected as indefinite for the recitation "on average, deriving at least 50%" in line 2.

Applicant has canceled claim 38, thereby alleviating this rejection.

The Examiner rejects claim 39 as indefinite for the recitation "A 38A24 maize plant selected from the population of 38A24 progeny maize plants".

Applicant has canceled claim 39, alleviating this rejection.

Claim 40 stands rejected for the recitation "further comprising applying double haploid methods" as rendering the claim indefinite. The Examiner states the recitation broadens the

scope of parent claim 37, which only involves crosses and does not encompass any double haploid method.

Applicant has canceled claim 40, thus alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 9-19 and 22-32 remain and claims 34-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed August 13, 2002. The Examiner states that the deposit of seed of plant 38A24 does not provide a description of the plants that are encompassed by the rejected claims, which have not been deposited. The Examiner further states the specification does not provide a description of the alleles of 38A24, nor does it describe the functions that are associated with each of the alleles of 38A24. The Examiner suggests that claims 12 and 25 be amended by listing the types of transgenes that may be introduced. Finally, the Examiner states that the specification does not mention any double haploid method.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution Applicant has canceled claims 9-11, 13-19, 22-24, 26-32, and 34-40, thus alleviating this rejection. In addition, Applicant has now amended claims 12 and 25 to include --contains one or more transgenes which have been stably integrated therein; said transgenes selected from the group consisting of: a plant disease resistance gene, an insect resistance gene, a herbicide resistance gene, and a male sterility gene--, thereby limiting the claims to the types of transgenes that may be introduced and that are supported by the specification on pages 38-44, as suggested by the Examiner.

Claim 33 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states the claim is drawn towards a method of making a hybrid plant

designated 38A24 comprising crossing inbred maize plants GE533340 and GE501400, however, the Examiner states the terms of this deposit are not known.

Applicant respectfully traverses this rejection. Applicant herein submits the Deposits section has been amended in order to properly include both the hybrid maize plant 38A24 and the inbred parents GE533340 and GE501400 within the Deposit paragraph on page 46. In addition, Applicant would like to reiterate that Applicant will refrain from deposit of Hybrid 38A24 and inbred parents GE533340 and GE501400 until allowable subject matter is indicated. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The specification has now been amended to correct these minor changes. The Applicant provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and
- e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 38A24 and the inbred parents GE533340 and GE501400 will be deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02) Such action is respectfully requested. Applicant thanks the Examiner for pointing out this inadvertent mistake.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 9-19 and 22-40 under 35 U.S.C. § 112, first paragraph.

**Summary**

Applicant acknowledges that claims 1-7 and 20 are allowed.

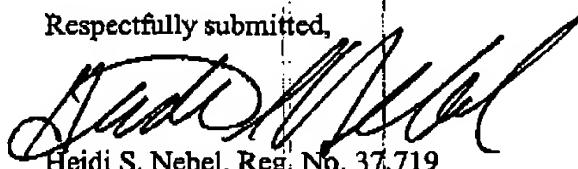
**Conclusion**

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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